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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,697	02/07/2002	Jeffrey M. Wendlandt	1001.1440101	2520

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EXAMINER

PANTUCK, BRADFORD C

ART UNIT PAPER NUMBER

3731

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/072,697

Applicant(s)

WENDLANDT, JEFFREY M.

Examiner

Bradford C Pantuck

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on October 30, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 13, 15, 16, 18 and 21 is/are rejected.
- 7) ☒ Claim(s) 10, 12, 14, 17, 19, and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on February 2<sup>nd</sup>, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-9, 11, 13, 15, 16, 18, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,016,369 to Parry. Regarding Claim 1, Parry discloses a clip, as shown in Figure 2, with two pieces. The first piece (2) has a first base (4) and a first projection (5) extending from the first base [see Fig. 1]. The second piece (3) has a second base (9) and a second projection (10) extending from the base [see Fig. 1]. The second projection includes multiple surfaces (interior), which define a reservoir (12). The two pieces are detachably connectable when the first projection (5) passes into the reservoir (12) [see Fig. 1; Column 2, lines 50-68].
2. Regarding Claim 2, Parry's first base (4) is a circular "disk" [Column 2, lines 55-56].
3. Regarding Claim 3, Parry's second base (9) is a circular "disk" [Column 2, lines 63-64].
4. Regarding Claim 4, Parry's clip has multiple surfaces that define a generally cylindrical surface of the reservoir (12) [see Fig. 1].
5. Regarding Claim 5, the first projection (5) of Parry's surgical clip extends perpendicular relative to the first base (4) [see Fig. 1].
6. Regarding Claim 6, the second projection (10) of Parry's surgical clip extends perpendicular relative to the second base (9) [see Fig. 2].

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7. Regarding Claims 7 and 8, the top surface of Parry's multiple surfaces is a puncturable material (14). The first projection (5) is adapted to pierce through the top surface (14) [Column 3, lines 21-24; Fig. 2].
8. Regarding Claim 9, the reservoir of Parry's clip contains a therapeutic agent—i.e. a sterilizing substance or other drug [Column 3, lines 1-3].
9. Regarding Claim 11, Parry discloses a second projection 10', in which an aperture is formed when the first projection (5') pierces it [Column 3, lines 21-24]. A therapeutic agent flows out of this aperture after the two pieces are connected [Column 2, lines 12-15].
10. Regarding Claim 13, Parry discloses the invention, as claimed, and as explained above. Further, the second projection of Parry's clip has an aperture, at the point where the tip of the first projecting portion (5) broke through the top surface (14) of the reservoir (12). The therapeutic agent flows out of the aperture [Column 3, lines 39-46]. Finally, the two pieces of Parry's clip are considered to be detachably connected because they could be pulled apart.
11. Regarding Claim 15, the mating of the first projection with the second projection forces therapeutic agent to flow out of sponge in the reservoir and out of the aperture [Column 3, lines 39-46].
12. Regarding Claims 16, 18, and 21, Parry discloses the invention as claimed, as detailed above. The clip attaches to the ear, which is made up of tissues including skin and blood vessels. The drug flows from the aperture created when component 7' pierces the puncturable portion 14'.

***Allowable Subject Matter***

13. Claims 10, 12, 14, 17, 19, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

14. Regarding Claim 1, Applicant's arguments filed October 30, 2003 have been fully considered but they are not persuasive. Parry discloses male and female members, which are detachably connected. Even though Parry explains that the two components of his clip form a "permanent connection," were one to apply enough force, the male member could be separated from the female member. The two pieces are not, for example, welded together. The only difference between the invention of the Applicant and the prior art is that *less force is needed* to pull the members apart in the Applicant's invention. It is not clear that this is a patentable distinction. In both cases one must *deform* either the male member or the female member in order to separate them. Applicant and Parry disclose the same structure: both disclose a male member with a barb and a female member with a lip for containing the barb.

Regarding Claims 13 and 16, Examiner suggests that Applicant insert the language discussed via telephone on December 23<sup>rd</sup>, 2003.

***Conclusion***

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 3,918,455 to Coplan

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (703) 305-8621. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

*BCP*  
BCP

December 29, 2003

  
MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700